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10/688,363

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James McCahill Denny JR.

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EXAMINER

RAJ, RAJIV J

ART UNIT

PAPER NUMBER

3686

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/688,363	Applicant(s) DENNY ET AL.	
	Examiner RAJIV J. RAJ	Art Unit 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 05 February 2009.
2. Claims 22-44 have been added.
3. Claims 1-21 have been canceled.
4. Claims 22-44 are pending and have been examined.

Priority

5. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 22-44 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409

U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). The process steps in claims (22-44) are not tied to a machine nor do they execute a transformation. Thus, they are non-statutory.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 22-23 & 25-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapman et al. (US 6879959 B1) (hereinafter Chapman) in view of Little et al. (US 5350509) (hereinafter Little) in further view of Provost et al. (US 6341265) (hereinafter Provost).

Claim 22

Chapman as shown, discloses the following limitations:

- *receiving a medical reimbursement claim electronically from the practice management computer system of the respective provider; (see at least Chapman Claim:1 Fig:3 Items:300-320 & related text)*
- *the claim including data about a patient of the respective provider; (see at least Chapman Fig:1 Items:100-140 & related text)*
- *a service provided to the patient by the respective provider, and the respective payer to whom the claim must be submitted for payment; (see at least Chapman Fig:2 Items:210-270 & related text)*
- *receiving a substantive response from the claims processing computer system of the respective payer regarding the claim; (see at least Chapman Column:5 Lines:1-22)*
- *presenting the formatted, substantive response from the claims processing computer system of the respective payer to the respective provider to enable the respective provider to determine if further action on the claim is necessary; (see at least Chapman Column:5 Lines:1-22)*

Chapman does not disclose the following limitation, however Little, as shown, does:

- *if the claim does not have any identifiable errors, formatting the claim into a format required by the claims processing computer system of the respective payer; (see at least Little Fig:4 Item:214 & related text)*
- *submitting the claim electronically to the claims processing computer system of the respective payer for payment determination in the format required by the claims processing computer system of the respective payer; (see at least Little Fig:2a-b, 3 Item:20, 28, 200-210 & related text)*
- *formatting the substantive response received from the claims processing computer system of the respective payer into a standardized format, wherein the standardized format is agnostic of the respective provider; (see at least Little Fig:2a-b, 3 Item:20, 28, 200-210 & related text)*

It would have been obvious to one of ordinary skill in the art to add the feature of Little into Chapman. One of ordinary skill in the art would have added this feature into Chapman with the motivation of providing a more efficient and accurate system and method for assessing claims and their value in regards to predetermined criteria. (see at least Little Column:4 Lines:23-43)

Chapman/Little do not disclose the following limitations, however Provost, as shown, does:

- *determining if the claim received from the practice management computer system of the respective provider has any one of a plurality of identifiable errors;; (see at least Provost Column:10 Lines:17-23)*

It would have been obvious to one of ordinary skill in the art to add the features of Provost into Chapman/Little. One of ordinary skill in the art would have added these features into Chapman/Little with the motivation of providing a more efficient, cost-effective and accurate process for preparing, submitting, correcting, and adjudicating health claims for improved medical care. (see at least Provost Column:3 Lines:24-38)

Claim 23

The combination of Chapman/Little/Provost discloses all the limitations of Claim 22. Chapman further discloses the following limitations:

- *the intermediary claim management system maintains list of identifiable errors in a database accessible by the intermediary claim management system;* (see at least Chapman Fig:3,4 Items:300-370 & related text)

Claim 25

The combination of Chapman/Little/Provost discloses all the limitations of Claim 22. Chapman further discloses the following limitations:

- *the step of determining if the claim has any one of the plurality of identifiable errors comprises identifying if required information is missing from the claim;* (see at least Chapman Fig:4 Items:350,410-420 & related text)

Claim 26

The combination of Chapman/Little/Provost discloses all the limitations of Claim

25. Chapman further discloses the following limitations:

- *the required information is mandated by the claims processing computer system of the respective payer; (see at least Chapman Fig:3 Items:300-370 & related text)*

Claim 27

The combination of Chapman/Little/Provost discloses all the limitations of Claim

25. Chapman further discloses the following limitations:

- *the required information is mandated by rules of one or more of the plurality of insurance payers; (see at least Chapman Column:7 Lines:47-67, Column:8 Lines:1-3)*

Claim 28

The combination of Chapman/Little/Provost discloses all the limitations of Claim

22. Chapman further discloses the following limitations:

- *the step of determining if the claim has any one of the plurality of identifiable errors comprises identifying if information within the claim is internally discrepant; (see at least Chapman Fig:3 Items:300-370 Fig:5 Items:510-550 & related text)*

Claim 29

The combination of Chapman/Little/Provost discloses all the limitations of Claim

28. Chapman further discloses the following limitations:

- *wherein information within the claim is internally discrepant if at least two pieces of information are not permitted to coexist within the claim based on a rule of the respective payer; (see at least Chapman Fig:3-5 Items:300-550 & related text)*

Claim 30

The combination of Chapman/Little/Provost discloses all the limitations of Claim

28. Chapman further discloses the following limitations:

- *information within the claim is internally discrepant if at least two pieces of information are not permitted to coexist within the claim based on a rule of the plurality of insurance payers; (see at least Chapman Fig:3-5 Items:300-550 & related text)*
- *and not based on a rule specific only to the respective payer; (Design Choice)*

Not based on a rule specific only to the respective payer is a design that is a mere matter of choice in ornamentality and produces no new mechanical effect or advantage does not constitute invention and "Counsel for appellant also present arguments relating to the proportioning and tightness of fit of appellant's devices. Those matters are considered to involve mechanical skill only and to produce no

such new or unexpected result as would justify the allowance of the appealed claims." (See, *In re Seid*, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947))

Claim 31

The combination of Chapman/Little/Provost discloses all the limitations of Claim

22. Chapman further discloses the following limitations:

- *if the claim has any one of the plurality of identifiable errors and before submitting the claim electronically to the claims processing computer system of the respective payer for payment determination, presenting the claim back to the respective provider for correction; (see at least Chapman Fig:3-5 Items:300-550 & related text)*

Claim 32

The combination of Chapman/Little/Provost discloses all the limitations of Claim

31. Chapman further discloses the following limitations:

- *the step of presenting the claim back to the respective provider comprises flagging the one or more identifiable errors in the claim that need to be corrected; (see at least Chapman Column:20 Lines:1-6)*

Claim 33

The combination of Chapman/Little/Provost discloses all the limitations of Claim

31. Chapman further discloses the following limitations:

- *the step of presenting the claim back to the respective provider comprises sending an email notification to the respective provider; (see at least Chapman Fig:1 Items:100-161 & related text)*

Claim 34

The combination of Chapman/Little/Provost discloses all the limitations of Claim

31. Little further discloses the following limitations:

- *the step of presenting the claim back to the respective provider comprises displaying the claim with the one or more identifiable errors to the respective provider on an interactive, web-accessible site generated and provided by the intermediary claim management system; (see at least Little Fig:4 Items:220 & related text)*

It would have been obvious to one of ordinary skill in the art to add the feature of Little into Chapman/Little/Provost. One of ordinary skill in the art would have added this feature into Chapman/Little/Provost with the motivation of providing a more efficient and accurate system and method for assessing claims and their value in regards to predetermined criteria. (see at least Little Column:4 Lines:23-43)

Claim 35

The combination of Chapman/Little/Provost discloses all the limitations of Claim

34. Chapman further discloses the following limitations:

- *the step of receiving edits to the claim from the respective provider directly within the interactive, web-accessible site; (see at least Chapman Column:3 Lines:48-67 Fig:2 Items:210-270 & related text)*

Claim 36

The combination of Chapman/Little/Provost discloses all the limitations of Claim

34. Chapman further discloses the following limitations:

- *the step of receiving the claim electronically back from the practice management computer system of the respective provider after the respective provider has corrected the claim internally within the practice management computer system; (see at least Chapman Fig:3-4 Items:310-420 & related text)*

Claim 37

The combination of Chapman/Little/Provost discloses all the limitations of Claim

22. Provost further discloses the following limitations:

- *the substantive response received from the claims processing computer system of the respective payer includes one of a rejection of the claim, a current status of the claim, a request for additional information associated with the claim, or an approval of the claim for payment; (see at least Provost Column:3 Lines:11-63)*

It would have been obvious to one of ordinary skill in the art to add the features of Provost into Chapman/Little. One of ordinary skill in the art would

have added these features into Chapman/Little with the motivation of providing a more efficient, cost-effective and accurate process for preparing, submitting, correcting, and adjudicating health claims for improved medical care. (see at least Provost Column:3 Lines:24-38)

Claim 38

The combination of Chapman/Little/Provost discloses all the limitations of Claim 37. Little further discloses the following limitations:

- *the rejection of the claim includes a rejection code of the respective payer;*
(see at least Little Column:17 Lines:20-42)

It would have been obvious to one of ordinary skill in the art to add the feature of Little into Chapman/Little/Provost. One of ordinary skill in the art would have added this feature into Chapman/Little/Provost with the motivation of providing a more efficient and accurate system and method for assessing claims and their value in regards to predetermined criteria. (see at least Little Column:4 Lines:23-43)

Claim 39

The combination of Chapman/Little/Provost discloses all the limitations of Claim 38. Little further discloses the following limitations:

- *the step of formatting the substantive response received from the claims processing computer system of the respective payer into the standardized*

format includes describing the rejection code in a human-understandable text format; (see at least Little Fig:4 Items:214 & related text)

It would have been obvious to one of ordinary skill in the art to add the feature of Little into Chapman/Little/Provost. One of ordinary skill in the art would have added this feature into Chapman/Little/Provost with the motivation of providing a more efficient and accurate system and method for assessing claims and their value in regards to predetermined criteria. (see at least Little Column:4 Lines:23-43)

Claim 40

The combination of Chapman/Little/Provost discloses all the limitations of Claim 22. Little further discloses the following limitations:

- *presenting a status of the submitted claim to the respective provider prior to receiving the substantive response from the claims processing computer system of the respective payer; (see at least Provost Column:3 Lines:11-63)*

It would have been obvious to one of ordinary skill in the art to add the features of Provost into Chapman/Little. One of ordinary skill in the art would have added these features into Chapman/Little with the motivation of providing a more efficient, cost-effective and accurate process for preparing, submitting, correcting, and adjudicating health claims for improved medical care. (see at least Provost Column:3 Lines:24-38)

Claim 41

The combination of Chapman/Little/Provost discloses all the limitations of Claim

22. Little further discloses the following limitations:

- *the step of presenting the formatted response from the claims processing computer system of the respective payer to the respective provider comprises displaying the formatted response to the respective provider on an interactive, web-accessible site generated by the intermediary claim management system; (see at least Little Fig:1 Items:28 Fig:4 Items:214 & related text)*

It would have been obvious to one of ordinary skill in the art to add the feature of Little into Chapman/Little/Provost. One of ordinary skill in the art would have added this feature into Chapman/Little/Provost with the motivation of providing a more efficient and accurate system and method for assessing claims and their value in regards to predetermined criteria. (see at least Little Column:4 Lines:23-43)

Claim 42

The combination of Chapman/Little/Provost discloses all the limitations of Claim

22. Chapman further discloses the following limitations:

- *the step of presenting the formatted response from the claims processing computer system of the respective payer to the respective provider*

comprises sending an email notification to the respective provider; (see at least Chapman Fig:1 Items:100-161 & related text)

Claim 43

The combination of Chapman/Little/Provost discloses all the limitations of Claim

22. Little further discloses the following limitations:

- *comprising storing the claim in a database of the intermediary claim management system; (see at least Little Column:4 Lines:4-20)*

It would have been obvious to one of ordinary skill in the art to add the feature of Little into Chapman/Little/Provost. One of ordinary skill in the art would have added this feature into Chapman/Little/Provost with the motivation of providing a more efficient and accurate system and method for assessing claims and their value in regards to predetermined criteria. (see at least Little Column:4 Lines:23-43)

Claim 44

The combination of Chapman/Little/Provost discloses all the limitations of Claim

22. Little further discloses the following limitations:

- *displaying a report about the claim to the respective provider on an interactive, web-accessible site generated and provided by the intermediacy claim management system; (see at least Little Column:16 Lines:66-68 Column:17 Lines:1-18)*

It would have been obvious to one of ordinary skill in the art to add the feature of Little into Chapman/Little/Provost. One of ordinary skill in the art would have added this feature into Chapman/Little/Provost with the motivation of providing a more efficient and accurate system and method for assessing claims and their value in regards to predetermined criteria. (see at least Little Column:4 Lines:23-43)

11. Claim 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapman in view of Little in view of Provost in further view of Wiggins (US 2002/0120473 A1) (hereinafter Wiggins).

Claim 24

The combination of Chapman/Little /Provost discloses all the limitations of Claim

23. Wiggins further discloses the following limitation:

- *the list of identifiable errors is derived from one or more of (i) rules provided directly by the respective payer, (ii) rules provided by one of the plurality of insurance payers, and (iii) rules based upon prior rejections of claims previously received by the intermediary claim management system from the claims processing computer system of the respective payer; (see at least Wiggins [0010-0014])*

It would have been obvious to one of ordinary skill in the art to add the feature of Wiggins into Little/Chapman/Provost. One of ordinary skill in the art would

have added this feature into Little/Chapman/Provost with the motivation to provide an improved invention for processing claims and ensuring the claims adhere to a set of requirements. (see at least Wiggins [0013-0019])

Response to Arguments

12. Applicant's arguments with respect to claims 22-44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAJIV J. RAJ whose telephone number is (571) 270-3930. The examiner can normally be reached on Monday thru Friday 8-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

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/RJR/
Patent Examiner Art Unit 3686
Date: 05/05/09

/Gerald J. O'Connor/
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